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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/670,749	09/25/2003	Kevin P. Parker	PRKR-4100	2758

7590 01/25/2007
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EXAMINER

GATES, ERIC ANDREW

ART UNIT	PAPER NUMBER
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3722

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/25/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/670,749

Applicant(s)

PARKER, KEVIN P.

Examiner

Eric A. Gates

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 August 2006 and 26 October 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11, 13-17, 19-21 and 23-28 is/are pending in the application.
- 4a) Of the above claim(s) 24-28 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 4-11, 13, 14, 19-21 and 23 is/are allowed.
- 6) ☒ Claim(s) 1 and 15-17 is/are rejected.
- 7) ☐ Claim(s) 2 and 3 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 May 2006 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>10/26/06 and 1/8/07</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 26 October 2006 has been entered.

Drawings

2. In addition to Replacement Sheets containing the corrected drawing figure(s), applicant is required to submit a marked-up copy of each Replacement Sheet including annotations indicating the changes made to the previous version. The annotated copies referred to in Applicant's amendment filed 28 August 2006 were not received. The marked-up copy must be clearly labeled as "Annotated Sheets" and must be presented in the amendment or remarks section that explains the change(s) to the drawings. See 37 CFR 1.121(d)(1). Failure to timely submit the proposed drawing and marked-up copy will result in the abandonment of the application.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 15 is rejected under 35 U.S.C. 102(b) as being anticipated by Jones (U.S. Patent 4,511,298).

5. Regarding claim 15, Jones discloses a book binding apparatus 10 for binding a stack of sheets L, said apparatus comprising: a first cover element 12 including a folded sheet 12 having a fold 20 which separates the folded sheet into first 16 and second 18 cover sections, with the first and second cover sections each having dimensions that generally correspond to dimensions of the sheets of the stack of sheets L; and an elongated spine element 14 having a longitudinal first edge 26 (the left side portion of 14 as seen in figure 8 forms a longitudinal edge at the fold) which extends along a length (length as seen in figure 3) of the elongated spine element 14, with the spine element length generally corresponding to a length of the fold and with the spine element and folded sheet 12 being attached together exclusively by way of a connection between regions immediately adjacent the longitudinal first edge 26 of the spine element and immediately adjacent the fold 20 in the folded sheet and with the spine element 14 including a substrate 14 and an adhesive matrix of heat activated adhesive (the adhesive matrix is integral with the substrate in the form of a film, such as Mylar, and is heated to adhesively attach it to the folded sheet, see column 3, lines 31-36)

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disposed on the substrate and extending substantially a full length of the elongated spine element 14.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lolli et al. (EP 0404751) in view of Pierson et al. (U.S. Patent 6,010,157).

8. Regarding claim 1, Lolli et al. discloses a book binding apparatus 1 for binding a stack of sheets 14, said apparatus comprising: a first cover element 3/4 including a first cover section 3 having dimensions that generally correspond to dimensions of the sheets, with said first cover section 3 being disposed substantially exclusively in a single plane (see figure 12); a first section (portion of 4 to the right of fold line 6) of adhesive disposed on the first cover section 3 along a first edge (left edge in figure 19) of the first cover section; a flap member 4A directly attached to the first cover section 3 and pivotable at a first location 6 along the first cover section 3, with the first location 6 being displaced from the first edge of the first cover section 3, with said flap member 4A extending substantially along a full length of the first edge of the first cover section 3 and with at least a portion of the first section of adhesive being disposed intermediate

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the first location and the first edge; and a second section 4 of adhesive disposed on a surface of said flap member 4A.

Lolli et al. does not disclose that the first and second section of adhesive is pressure sensitive adhesive, or that first and second release liners are disposed over the adhesive, or said flap member being movable between a closed position where the first release liner can contact said second release liner and an open position where the flap member is positioned away from said first release liner. Pierson et al. teaches the use of first and second sections 48a/48b of pressure sensitive adhesive that have first and second 50a/50b release liners disposed over them for the purpose of having an adhesive that doesn't require heat activation and that has covers that prevent the adhesive from premature binding. Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to have combined the apparatus of Lolli et al. with the pressure sensitive adhesive and liners of Pierson et al. in order to have a binding apparatus that can be used without the need for heating equipment.

It is also evident that the modified invention of Lolli et al. would have said flap member 4A being movable between a closed position (if first cover section 3 is folded along fold line 6 prior to the stack of sheets being inserted) where the first release liner can contact said second release liner and an open position where the flap member is positioned away from said first release liner.

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9. Claims 16-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jones in view of Giulie.

10. Regarding claim 16, Jones discloses the invention substantially as claimed, except Jones does not disclose wherein the adhesive matrix defines a multiplicity of spaced apart longitudinal grooves that facilitate folding of the spine element.

Giulie teaches the use of a heat activated adhesive matrix that comprises a multiplicity of spaced apart longitudinal grooves 17 for the purpose of facilitating folding of a spine element 12. Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to have combined the binding apparatus of Jones with the adhesive matrix of Giulie in order to have a spine element that is easier to fold.

11. Regarding claim 17, the modified invention of Jones discloses wherein the elongated spine element 14 further includes a pressure sensitive adhesive 28 disposed along the longitudinal second edge 24 of the spine element and a release liner 30 disposed over the pressure sensitive adhesive.

Allowable Subject Matter

12. Claims 4-11, 13-14, 19-21, and 23 are allowed.

13. Claims 2 and 3 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

14. Applicant's arguments filed 28 August 2006 regarding claim 15 have been fully considered but they are not persuasive.

15. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., that "Jones uses a pressure sensitive for binding rather than a heat activated adhesive" and that "since only the central portion of transparent tape is connected to anything, both outer edges of the "elongated spine element" 14 are free") are not recited in the rejected claim(s). The heat activated adhesive portion of the spine element is addressed in the rejection of claim 15 above. Spine element 14 obtains a new edge in the center portion of the element when folded as in figure 8, which is also addressed in the rejection of claim 15 above. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

16. Applicant's arguments with respect to claim 1 have been considered but are moot in view of the new ground(s) of rejection.

17. For the reasons as set forth above, the rejections are maintained.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eric A. Gates whose telephone number is 571-272-5498. The examiner can normally be reached on Monday-Thursday 7:45-6:15.

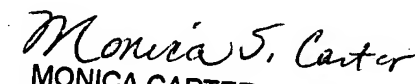
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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Monica Carter can be reached on 571-272-4475. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



EAG
18 January 2007


MONICA CARTER
SUPERVISORY PATENT EXAMINER